LIBRARY
SUPREME COURT, U. S.

FILED
JUL 24 1975
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-1644

JOHN C. SHEEHAN,

Petitioner,

—v.—

FRANK P. DOYLE, *et al.*,

Respondents.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

ALBERT L. JACOBS, JR.
Attorney for Respondents
521 Fifth Avenue
New York, New York 10017
Tel.: (212) 687-1636

Of Counsel:

ALBERT L. JACOBS
MARK H. SPARROW

JACOBS & JACOBS, P. C.
521 Fifth Avenue
New York, New York 10017

TABLE OF CONTENTS

PAGE

Statement of the Case 1

Summary of Argument 2

REASONS FOR DENYING THE WRIT:

I. There Is No Conflict Among Any of the Courts of Appeals With Respect to Obtaining Discovery Under the Federal Rules of Civil Procedure From a Nonresident Alien 3

II. The Decision of the First Circuit Court of Appeals Was Correct 6

III. The Judgment of the First Circuit Court of Appeals Is Correct on Three Additional Grounds Beyond the Specific Reasons Set Forth by That Court for Reaching Its Conclusion 6

CONCLUSION 11

TABLE OF AUTHORITIES

Cases:

Babcock & Wilcox Co. v. Combustion Engineering, Inc., 430 F.2d 1177 (C.A. 2 1968), which affirmed 314 F. Supp. 235 (D. Conn. 1968) 3

Babcock & Wilcox Co. v. Foster Wheeler Corporation, 174 U.S.P.Q. 145 (D.C. N.J. 1972) 7

Best v. Great Northern Railway Co. (D.C. Mont., 1917), 243 F. 789 9

PAGE

Duffy v. Barneset et al., No. 74-1200 5

Frilette et al. v. Kimberlin et al., No. 74-1156 5

Gladrow v. Weisz, 354 F.2d 464 (C.A. 5 1965) 3

Hall v. Great Northern Railway Co., 197 F. 488 (D.C. Mont., 1972) 9

H. G. Baker & Bro. v. Pinkham, 211 F. 728 (D.C. S.C., 1914) 9

Hogan v. Zletz, 151 U.S.P.Q. 103 (D.C. N.D., Okla. 1966) 4

James Halcott Inc. v. Allahabad Bank Limited, 444 F.2d 451 (C.A. 5, 1971), cert. den'd, 404 U.S. 940, 92 S.Ct. 380 9

Korman v. Shull, 184 F. Supp. 928 (D.C. W.D. Mich., 1960) 4

Lomax v. Kihara v. Von der Ohe, 175 U.S.P.Q. 538 (D.C. D.C., 1972) 4, 5

Natta v. Hogan, 392 F.2d 686 (C.A. 10 1968) 4

Natta v. Zletz, 379 F.2d 615 (C.A. 7 1967) 4

Niccum v. Northern Assur. Co., 17 F.2d 160 (D.C. Ind., 1927) 9

Sandusky Foundry & Machine Co. v. DeLavaud, 251 F. 631 (1918, D.C. Ohio) 7

Tierney v. Helvetia Swiss Fire Insurance Co., 193 F. 82 (C.C. N.Y., 1908) 10

PAGE

Wind River Lumber Co. v. Frankfort Marine Accident and Plate Glass Insurance Co., 196 F. 340 (D.C. Oregon, 1912) 10

Rules:

Federal Rules of Civil Procedure:

Rule 34 ..... 1, 2, 3, 5, 6, 11
Rule 37 ..... 10, 11

Statutes:

United States Code:

28 U.S.C. 1391(d) 7, 9
35 U.S.C. 24 ..... 1, 6, 9

Other Authorities:

Barron and Holtzoff, *Federal Practice and Procedure*, Vol. 1, Section 79, page 384 (1960) 9
Moore's Federal Practice, Vol. 7B (1972), JC 582 and 583 8

IN THE

Supreme Court of the United States

OCTOBER TERM, 1974

No. 74-1644

JOHN C. SHEEHAN,

Petitioner,

—v.—

FRANK P. DOYLE, *et al.*,

Respondents.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

Statement of the Case

Petitioner is requesting this Court to review the judgment of the United States Court of Appeals for the First Circuit which held that Petitioner could not take discovery from Respondents who are nonresident aliens under Rule 34 of the Federal Rules of Civil Procedure in an ancillary proceeding allegedly brought under 35 U.S.C. 24.

Petitioner, John C. Sheehan, attempted to take discovery under Rule 34 of the Federal Rules of Civil Procedure from Frank Peter Doyle, John Herbert Charles Nayler and George Newbolt Rolinson, who are all British subjects and are nonresident aliens. Petitioner and Respondents are

involved in an interference proceeding in the United States Patent and Trademark Office. Petitioner is a United States citizen residing in Lexington, Massachusetts. Respondents are all residents of Great Britain and have had no contacts with the State of Massachusetts except for their prior application to the District Court in Massachusetts for a subpoena duces tecum which was served on Petitioner after he had refused to produce documents pursuant to a request under Rule 34 of the Federal Rules of Civil Procedure.

As stated on page 5 of Petitioner's Petition for a Writ of Certiorari, Respondents could not be subpoenaed because they are aliens not present in the United States.

Summary of Argument

I. There is no conflict among any of the Courts of Appeals with respect to obtaining discovery under the Federal Rules of Civil Procedure from a nonresident alien.

II. The decision of the First Circuit Court of Appeals was correct.

III. The judgment of the First Circuit Court of Appeals is correct on three additional grounds beyond the specific reasons set forth by that Court for reaching its conclusion.

REASONS FOR DENYING THE WRIT

I.

There Is No Conflict Among Any of the Courts of Appeals With Respect to Obtaining Discovery Under the Federal Rules of Civil Procedure From a Nonresident Alien.

Petitioner has alleged as the first reason for granting the Writ that there is a conflict among the Courts of Appeals relating to discovery for use in Patent Office interferences. It must be remembered that the present case involves the attempt by Petitioner to take discovery under Rule 34 of the Federal Rules of Civil Procedure from three nonresident aliens who reside in Great Britain and who were not and could not be subpoenaed.

An analysis of the cases relied upon by Petitioner on page 6 of his Petition for a Writ of Certiorari clearly demonstrates that the facts of each of the cases relied upon differ materially from that of the present case. In *Babcock & Wilcox Co.* v. *Combustion Engineering, Inc.,* 430 F.2d 1177 (C.A. 2 1968), which affirmed 314 F. Supp. 235 (D. Conn. 1968), both parties were United States corporations and Babcock & Wilcox had served six subpoenas on employees of Combustion Engineering, Inc. Combustion Engineering then brought a motion to vacate the six subpoenas which had been served. The Second Circuit affirmed the District Court's denial of the motion to vacate the subpoenas.

In *Gladrow* v. *Weisz,* 354 F.2d 464 (C.A. 5 1965) production of documents was sought during Weisz's cross-examination of Gladrow. Gladrow refused to produce certain

documents and Weisz then moved in a District Court for an order requiring Gladrow to produce the documents. The District Court's order granting the motion to compel production was affirmed by the Fifth Circuit.

In *Natta* v. *Zletz,* 379 F.2d 615 (C.A. 7 1967), Natta sought production of documents from the files of Standard Oil Company of Indiana, a United States company. The Seventh Circuit directed that such production be effected.

In *Natta* v. *Hogan,* 392 F.2d 686 (C.A. 10 1968), Natta brought a proceeding in the District Court for the Northern District of Oklahoma against Phillips Petroleum Co., a United States company, requesting discovery under Rule 34 of the Federal Rules of Civil Procedure. The Tenth Circuit affirmed the order for production.

In *Korman* v. *Shull,* 184 F. Supp. 928 (D.C. W.D. Mich. 1960), H. B. Allen, Secretary of the Upjohn Company and Hogg and Korman, who were parties, were served with subpoenas. In that case, the District Court decided, *inter alia,* that good cause for the production of documents was not shown and granted the motion to quash.

In *Hogan* v. *Zletz,* 151 U.S.P.Q. 103 (D.C. N.D. Okla. 1966), the District Court for the Northern District of Oklahoma found that service of process on Phillips Petroleum Company, a United States corporation, was satisfactory and directed the production sought by Zletz from that company.

In *Lomax* v. *Kihara* v. *Von der Ohe,* 175 U.S.P.Q. 538 (D.C. D.C. 1972), the District Court for the District of Columbia denied Von der Ohe's motion to quash the subpoena served on him by Lomax.

Except for *Lomax* v. *Kihara, supra,* all of the above cases involved the procedures for discovery which were superseded by the 1971 Amendments to the Federal Rules of Civil Procedure.

The "old" procedures required that a motion for discovery be brought in a court having jurisdiction over the parties. Thus, when a District Court ordered discovery, the Court was one having subject matter jurisdiction, personal jurisdiction, and one where venue was properly laid.

None of the above cases involved an attempt to take discovery from a nonresident alien under Rule 34 of the Federal Rules of Civil Procedure. Because of this fundamental difference in the fact situation of the present case and those cases cited by Petitioner, it is submitted that there is no conflict among the Circuit Courts of Appeals and, thus, the present case does not warrant granting of the Petition for Writ of Certiorari.

The Court's attention is called to its recent denial on May 19, 1975, of Petitions for Writs of Certiorari in *Frilette et al.* v. *Kimberlin et al.,* No. 74-1156, and *Duffy* v. *Barneset et al.,* No. 74-1200, which involved the place of federal court discovery in a Patent Office Interference.

II.

The Decision of the First Circuit Court of Appeals Was Correct.

The facts of the present case are unique. There is no decision prevailing in any of the Circuits which provides that a nonresident alien can be compelled to produce documents and materials under Rule 34 of the Federal Rules of Civil Procedure in a jurisdiction in which he cannot be subpoenaed, in an ancillary action under 35 U.S.C. 24 for the sole purpose of taking discovery for use in a Patent Office interference. It is, therefore, submitted that the decision of the First Circuit Court of Appeals was correct when it refused to permit Petitioner to take such discovery from Respondents who are nonresident aliens residing in Great Britain.

III.

The Judgment of the First Circuit Court of Appeals Is Correct on Three Additional Grounds Beyond the Specific Reasons Set Forth by That Court for Reaching Its Conclusion.

In addition to the reasons in support of its judgment, there are three other grounds which fully support the First Circuit's judgment below.

Since Respondents are all nonresident aliens residing in Great Britain, both the District Court in Massachusetts and the First Circuit lacked personal jurisdiction over the Respondents. Except for their prior application to the District Court in Massachusetts for a subpoena duces tecum,

Respondents have had no contact with the State of Massachusetts. They do not conduct any business within the state nor do they have any of the minimal contacts required in order to assert personal jurisdiction over them. Under *Babcock & Wilcox Co.* v. *Foster Wheeler Corporation,* only at 174 U.S.P.Q. 145 (D.C. N.J. 1972), a District Court does not gain jurisdiction over a party to a patent interference merely because that party previously applied to that court for discovery.

Secondly, venue was improperly laid in the District Court in Massachusetts because, while 28 U.S.C. 1391(d) provides that an alien may be sued in any district, this statutory provision has been construed to mean that an alien can be sued in any district in which he can be properly served.

28 U.S.C. 1391(d) abrogates the normal venue requirements for the case of an alien since an alien, by definition, neither resides nor conducts business in a particular jurisdiction. 28 U.S.C. 1391(d) provides that an alien can be sued in any district. It is clear from the case law that this section does not literally mean than an alien can be sued in any district that a plaintiff chooses regardless of whether or not the alien can be found there, but rather that an alien can be sued in any district in which valid service of process can be had upon him. In *Sandusky Foundry & Machine Co.* v. *DeLavaud* (1918, D.C. Ohio), 251 F. 631, the District Court stated that an alien could be sued in any district in which he could be served. At page 632, the District Court went on to say,

> "The defendants who have appeared are aliens. It seems to be settled that they are not inhabitants of

> any district, and may be sued in any district within which process can be served on them. It was so held under what is now Section 48 of the Judicial Code Act, March 3, 1911, c. 231, 36 State 1100 [Comp. St. 1916, §§1024, 1030], in United Company v. Dupleiss Co. (C.C.), 133 F. 920. . . . The same holding has been repeatedly made under Section 51 of the Judicial Code (Comp. St. 1916, §1033) as applied to causes of action other than suits arising under the patent laws. In re Hohost, 150 U.S. 653, 14 S.Ct. 221; Barrow Steamship Co. v. Kane, 170 U.S. 100, 18 S.Ct. 526. . . . "

Since an alien can only be sued in any district in which he can be validly served, it is believed clear that an alien can only be discovered in a judicial district where he can either be found or with which some nexus exists.

Moore's Federal Practice, Vol. 7B (1972), JC 582 and 583, also discusses Section 1391(d):

> "Prior to the Judicial Code revision of 1948 there were no express provisions in the venue statutes which dealt directly with aliens. The courts had forged their venue rules, and decided that inasmuch as an alien was not an 'inhabitant' of any judicial district he could be sued in any district *where valid service of process could be* [sic] *obtained.* [Emphasis added.] And this rule applied equally to individuals as well as to alien corporations. Subsection (d) [of 28 U.S.C. 1391] gives statutory recognition to those propositions."

Thus, an alien may only be sued in any district where valid service of process can be obtained.

Attention is also directed to Barron and Holtzoff, *Federal Practice and Procedure*, Vol. 1, Section 79, page 384 (1960), where it is stated that,

> An alien is districtless, and may be sued in any district in which he can be served with process.

In support of this are cited *Niccum* v. *Northern Assur. Co.* (D.C. Ind., 1927), 17 F.2d 160, and *H. G. Baker & Bro.* v. *Pinkham* (D.C. S.C., 1914), 211 F. 728. Attention is also directed to *James Halcott Inc.* v. *Allahabad Bank Limited* (C.A. 5, 1971), 444 F.2d 451, cert. den'd, 404 U.S. 940, 92 S.Ct. 380, which state that 1391(d) has nothing to do with acquiring personal jurisdiction, and that while an alien may be sued for venue purposes in any district in the United States he still has to be properly served with process.

The present fact situation is really one step removed from a plenary action on which venue is posited under 28 U.S.C. 1391(d). The proceeding in the District Court below was alleged to be an ancillary proceeding pursuant to 35 U.S.C. 24, seeking discovery for use in connection with a Patent Office interference. It is believed that the requirements of subject matter jurisdiction, personal jurisdiction over the parties *and* proper venue must all be met, not only in a plenary proceeding, but in an ancillary proceeding under 35 U.S.C. 24. There is no basis either for waiving personal jurisdiction or for disregarding the case law supportive of §1391(d) which requires that an alien can be sued in any federal district where the alien can be found and served. [See also *Best* v. *Great Northern Railway Co.* (D.C. Mont., 1917), 243 F. 789; *Hall* v. *Great Northern Railway*

Co. (D.C. Mont., 1912), 197 F. 488; *Wind River Lumber Co.* v. *Frankfort Marine Accident and Plate Glass Insurance Co.* (D.C. Oregon, 1912), 196 F. 340; *Tierney* v. *Helvetia Swiss Fire Insurance Co.* (C.C. N.Y., 1908), 193 F. 82.]

Petitioner has admitted on page 5 of his Petition for Writ of Certiorari that Respondents cannot be served in Massachusetts.

Thirdly, Petitioner failed to comply with the requirements of Rule 37 of the Federal Rules of Civil Procedure when he moved the Massachusetts District Court for an order directing Respondents to produce the documents and materials sought. Rule 37 expressly requires that a motion to compel discovery must be made to the Court in which *the action is pending.* No action was pending in the District Court for Massachusetts. Therefore, that Court was not the proper Court in which to bring a motion to compel production. Petitioner's action contravenes Rule 37 of the Federal Rules of Civil Procedure by bringing the motion to compel in the wrong Court. This fact coupled with the District Court's lack of personal jurisdiction and the improper laying of venue support the correctness of the decision of the First Circuit.

CONCLUSION

The present case is not one which contains any of the factors customarily considered by this Court as a basis for granting a Petition for Writ of Certiorari.

There is no conflict among the Courts of Appeals because no Court of Appeals has previously come to a contrary decision on a similar fact situation. The present case is unique in that it is the only case involving an attempt by a United States citizen to take discovery from nonresident aliens under Rule 34 of the Federal Rules of Civil Procedure.

Since the fact situation is unique, the present case is not one likely to be encountered or one which will have a far ranging impact on United States law as a whole.

In addition to the reasons set forth by the First Circuit in support of its judgment, there are at least three additional grounds which fully support the conclusions arrived at by the First Circuit in finding that discovery under Rule 34 of the Federal Rules of Civil Procedure was not appropriate against the Respondents. Neither the District Court of Massachusetts nor the First Circuit had personal jurisdiction over Respondents who are nonresident aliens residing in Great Britain. Venue was improperly laid in Boston, Massachusetts. And the motion to compel production was not brought before a Court in which the action was pending as required by Rule 37 of the Federal Rules of Civil Procedure.

It is, therefore, submitted that the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

ALBERT L. JACOBS, JR.
Attorney for Respondents
521 Fifth Avenue
New York, New York 10017
Tel.: (212) 687-1636

Of Counsel:

ALBERT L. JACOBS
MARK H. SPARROW

JACOBS & JACOBS, P. C.
521 Fifth Avenue
New York, New York 10017